

REMARKS

No claims have been amended, added or cancelled in the present response. Therefore, claims 1-32 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Provisional Double Patenting Rejection:

The Examiner provisionally rejected claims 1-32 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of co-pending U.S. Application No. 10/090,893. If and/or when this rejection becomes non-provisional, Applicants will consider filing a terminal disclaimer or present reasons traversing the rejection.

Section 103(a) Rejection:

The Examiner rejected claims 1-32 under 35 U.S.C. § 103(a) as being unpatentable over Mendez et al. (U.S. Patent 5,961,590) (hereinafter “Mendez”) in view of Boucher et al. (U.S. Patent 6,725,421) (hereinafter “Boucher”). Applicants respectfully traverse this rejection for at least the reasons presented below.

Regarding claim 1, Mendez in view of Boucher does not teach or suggest a server configured to exclude one or more formats for content of a document in a server format from a small device document, as the Examiner contends. The Examiner relies on Mendez to teach this limitation, and cites column 13, lines 1-15 and column 17, lines 14-34. However, neither of these citations describes a server excluding formats for content from a document. The first citation describes a global format in which a server stores e-mail. Mendez describes two additional formats and teaches that the global format “may be the same as Format A or Format B or may include the combined elements of both formats.” This portion of Mendez clearly does not teach a server configured to exclude one or more formats for content of a document in a server format from a small device

document.

The second passage in Mendez cited by the Examiner generically discusses that the e-mail module of Mendez' web engine stores downloaded emails either in RAM or in more persistent storage. However, Mendez does not mention anything about excluding formats for content when converting between the various formats. The Examiner's second citation in Mendez describes a process for downloading client e-mails and has nothing to do with the formats of the e-mails, nor with excluding formats from a document in a server format to generate a document in a small device format, as recited in claim 1. The fact that Mendez teaches that emails messages may be downloaded, stored, and converted between different formats does not teach or suggest the specific functionality of a server excluding formats for context of a document in a server format from a small device document.

Therefore, the Examiner's proposed combination of Mendez in view of Boucher clearly fails to teach or suggest a server configured to exclude one or more formats for content of a document in a server format from a small device document.

Further regarding claim 1, Mendez in view of Boucher does not teach or suggest that the server is configured to restore the one or more formats for content of the document in the server format excluded from the small device document, as the Examiner contends. The Examiner admits that Mendez does not teach this limitation and relies on Boucher, citing the Abstract, column 6, lines 7-14, column 11, lines 19-29 and column 21, line 60 – column 22, line 6. However, Boucher also fails to teach anything about a server configured to restore one or more formats for content excluded from a small device document. The Examiner first cites the abstract of Boucher, which describes a method and apparatus for storing, retrieving and playing multimedia data. Presumably, the Examiner is referring to the description of "restor[ing] the semantic representation" as part of playing content from a rendered cache. However, Boucher's restoring of semantic representation does not refer to a server restoring one or more formats for content excluded from a small device document. Instead, the semantic representation of Boucher

is derived by a rendering or layout process used to prepare multimedia content for display. Boucher is referring to the use of cache of rendered multimedia content that may be combined with semantic content, such as textual descriptions, when being rendered to a client display. Boucher is not restoring content format that was excluded previously, but instead describes caching and reusing multimedia content in later renderings. When Boucher's semantic representations is "restored", it is combined with multimedia content for display.

The Examiner's second citation (column 6, lines 7-14) actually supports Applicants' argument above. This passage gives a definition of the term "render", as including "the process of generating or converting multimedia data... into a format that can be played." While this passage describes a data conversion that allows multimedia data to be displayed on various client devices (displays, computer monitors or television), it does not describe restoring one or more formats for content of a document in server format that were excluded from a small device document, as recited in claim 1.

In the Examiner's third and fourth citations from Boucher (column 11, lines 19-29; column 21, line 60 - column 22, line 6), the Examiner refers to Boucher's teaching regarding how semantic content may be stored in an XML-based format. Boucher instead teaches that semantic content (locations, sizes, shapes, and target universal resource identifiers of hyperlinks, multimedia element timing, and other content play instructions) can be stored in XML format, or in another format independent of the storage mechanism, that the format of semantic content can avoid unneeded complexity, and that it can be used to render multimedia content for display by a rendering system that understands the content play instructions. However, the semantic content of Boucher is not a document generated by excluding one or more formats for content from a server document to generate a small device document, but is instead a second data object type derived by a rendering or layout process. Moreover, Boucher fails to mention anything about restoring formats for content that were excluded from a document. Thus, there are no formats for content to be "restored" to a document as recited in claim 1. Instead, Boucher uses the term "restoring" to mean rendering a display based on the content play

instructions of the semantic content and previously rendered and cached multimedia data. Nowhere does Boucher describe a server configured to restore one or more formats for content of a document that were previously excluded from a small device document by the server. Since neither Mendez, as admitted by the Examiner, nor Boucher teach or suggest a server configured to restore the one or more formats for content of the document in the server format excluded from the small device document, the Examiner's combination of Mendez and Boucher clearly fails to teach or suggest this limitation.

The Examiner also asserts that it would have been obvious to incorporate the technique of restoring the original format as taught by Boucher into the Mendez apparatus in order to utilize the modified version process because doing so would provide the flexibility to the Web client to select and modify the format using any network devices. However, as discussed above, Boucher does not teach restoring original (server) format to a document in a client (small device) format. In fact, Boucher's techniques for rendering multimedia content have nothing to do with Mendez' method for downloading and storing email messages. Thus, the proposed combination would make no sense. Additionally, the Examiner's proposed combination of Boucher and Mendez would not result in a system that includes a server configured to exclude one or more formats from a document to generate a document in a small device format, and also configured to restore the previously excluded formats to the small client document to generate a document in the server format. Instead the Examiner's combination of Mendez and Boucher would result in a system that can download and store email messages, as taught by Mendez, as well as use two types of data objects for displaying multimedia content, as taught by Boucher.

In further regard to claim 1, the Examiner takes Official Notice that "information relating to the content and/or the format of the converted text was well-known in the art", citing Marmor (U.S. Patent 6,601,108). Pursuant to M.P.E.P. § 2144.03, Applicant traverses the Examiner's taking of Official Notice. Firstly, it is not clear what the Examiner is taking Official Notice of. The Examiner only states that "the information relating to the content and/or the format of converted text" was well known. To what

information is the Examiner referring? Is the Examiner suggesting that any (or ALL) information relating to content for format for converted text was well known? The Examiner refers to the Marmor reference, but does not provide any citation or explanation regarding the specific teaching the Examiner is asserting was well known in the Official Notice. Applicants respectfully request that the Examiner provide a more detailed description of the specific teachings or functionality that the Examiner is asserting as well known through the taking of Official Notice. Furthermore, pursuant to M.P.E.P. § 2144.03 Applicants assert that “the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. Applicants note that the Examiner does refer to the Marmor patent, but, as noted above, without a better description of what the Office Notice is intended to cover, it is not possible to determine whether or not the Marmor patent provides any evidence to support the Examiner’s taking of Office Notice. See also 37 CFR 1.104(c)(2), (d)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Furthermore, just because some information relating to content or format is known in the art does not in any way suggest Applicants’ claimed invention.

For at least the reasons above, the rejection of claim 1 is not supported by the prior art and removal thereof is respectfully requested. Similar remarks apply also to independent claims 10, 19 and 27.

Applicants also assert that numerous other ones of the dependent claims recite further distinctions over the cited art. However, since the rejection has been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.

CONCLUSION

Applicants submit the application is in condition for allowance, and prompt notice to that effect is respectfully requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above-referenced application from becoming abandoned, Applicants hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-10700/RCK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☐ Petition for Extension of Time
- ☐ Notice of Change of Address
- ☐ Other:

Respectfully submitted,



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